TFW 1653

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

van Gilst et al.

Serial No.: 10/500,913

Filed: November 29, 2004

For: USE OF ERYTHROPOIETIN FOR THE PREVENTIVE OR CURATIVE TREATMENT OF CARDIAC FAILURE

Confirmation No.: 7130

Examiner: R. Mondesi

Group Art Unit: 1653

Attorney Docket No.: 2578-6485US

CERTIFICATE OF MAILING

I hereby certify that this correspondence along with any attachments referred to or identified as being attached or enclosed is being deposited with the United States Postal Service as First Class Mail on the date of deposit shown below with sufficient postage and in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

June 1, 2006
Date

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Aubry Blackburn
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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are submitted in response to the Communication mailed May 8, 2006. Claims 1-22 are currently pending in the application. Claims 1-22 are subject to a restriction requirement. Applicants provisionally elect, with traverse, Group I, claims 1-5, drawn to a method of treating a patient suffering from, or at risk of suffering from a chronic coronary syndrome.

Applicants respectfully traverse the restriction and submit that the Groups identified as Group I (claims 1-5), Group II (claim 6), Group III (claims 7-11), Group IV (claims 12-19) and Group V (claims 20-22) in the Office Action should be joined and examined as a single group, which applicants elect. As such, applicants request reconsideration of the restriction requirement.

The Examiner alleges that the technical feature linking Groups I-V is that they all relate to the use of a composition comprising erythropoietin (EPO) for the treatment of a coronary related disease. Furthermore, the Examiner asserts that, because WO 01/82952 (cited in the IDS filed July 8, 2004) allegedly teaches a composition comprising EPO for the treatment of coronary related diseases, the technical feature linking the inventions of Groups I-V does not constitute a special technical feature that defines a contribution over the prior art.

However, contrary to the Examiner's assertions, applicants respectfully submit that Groups I-V relate to a single general inventive concept under PCT Rule 13.1 and include special technical features according to PCT Rule 13.2 that define a contribution over the prior art. More specifically, each of the pending claims in asserted Groups I-V relate to EPO, or a derivative or functional analogue thereof, that is produced in a host cell expressing at least the E1A protein of an adenovirus. As stated in paragraph [0008] of the specification, the EPO produced from a host cell expressing at least the E1A protein of an adenovirus decreases undesirable side effects, such as increased hematocrit, caused by using an EPO from a non-E1A expressing host cell. Therefore, the common element of an EPO, or derivative or functional analogue thereof, is a technical feature common to all Groups I-V that should be considered when assessing unity of invention for the referenced application.

Furthermore, applicants submit that WO 01/82952 does not teach EPO, or derivatives or functional analogues thereof, that are produced in a host cell expressing at least the E1A protein of an adenovirus. Accordingly, WO 01/82952 does not show that the special technical feature does not define a contribution over the prior art.

Therefore, it is respectfully submitted that the claims of Groups I-V all relate to a common special technical feature defining a contribution over the prior art comprising EPO, or a derivative or functional analogue thereof, that is produced in a host cell expressing at least the E1A protein of an adenovirus. As such, the pending claims 1-22 share a unity of invention under PCT Rule 13.1 because they relate to a single general inventive concept.